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10/561,123	10/19/2006	Boydan Joseph Mudryk	SPRU-03	5935
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EXAMINER				
ADDIE, RAYMOND W				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,123

Applicant(s)

MUDRYK ET AL.

Examiner

Raymond W. Addie

Art Unit

3671

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 and 40 is/are rejected.
- 7) ☒ Claim(s) 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CD/CD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7, 9, 13-18, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Pellowski # 3,362,305.

Pellowski discloses a roadside post (10) having a substantially arcuate transverse cross-section and made of spring steel. See Col. 2, Ins 25, 26.

The post (10) being elastically bendable through 90 degrees upon impact by a vehicle or the like. See Col. 2, Ins. 27-30.

A surface coating (35), such as a colorant, disposed on both front and rear surfaces of the sheet of spring steel (10). See Col. 4, Ins. 35-45.

With respect to claims 9, 13, 14, 17, 24 Pellowski discloses the post (10) has a substantially arcuate shape, which inherently includes a central web and two lateral flanges extending therefrom.

Further, Pellowski discloses the post (10) has a lower end (11) that is tapered, thereby adapting the post for being driven into the ground. See Col. 3, Ins. 20-27.

With respect to claims 15, 16 Pellowski discloses the post (10) is provided with a plurality of holes (16) adjacent the lower end (11) of the post (10) to aid in holding the post (10) firmly in the ground to a desired depth. See Col. 3, Ins. 31-37; Fig. 5.

With respect to claims 18, 21, 25, 28 Pellowski discloses at least one recess (12) can be formed in the ground, for receiving said roadside post (10). And arcuate recesses (14) can be formed when "the strip element (10) is flexed or bent over in opposite directions to a generally horizontal condition, whereby to form arcuate surfaces (14) which extend outwardly from the opposite sides of the strip element (10)...Figures 4, 5...the strip element (10) may be flexed or bent more easily, and the life and durability of the strip element (10) is greatly increased". See Col. 2, Ins. 39-62.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9, 10-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Stirtz # 5,238,322 in view of Hendrickson # 2,646,969 and Mudryk et al. # 6,267,529 B1.

Stirtz discloses a roadside post (10) comprising:

An elongate body (10a, b) formed of a single sheet of flexible material.

The body having a central web portion (20) and two lateral flanges (21, 22).

As illustrated the lateral flanges forming an interior angle of 150-175 degrees relative to the central web portion. See Fig. 1.

The body being elastically bendable through 90 degrees, such as when impacted by a vehicle, such that the body can return to its original upright position after the impact.

See Col. 1, ln. 49-col. 2, ln. 23.

What Stirtz does not disclose is the use of spring steel and a surface coating.

However, Stirtz explicitly recites the advantages of using a heat treatable material.

Further, Hendrickson teaches it is known to use heat treated spring steel for roadside support posts (14). The support posts store and release a maximum amount of energy and increase the time in which the road shocks (vehicle impacts) are absorbed and released. See Col. 2, lns. 33-50. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to make the roadside post of Stirtz, from heat treated spring steel, as taught by Hendrickson, in order to improve impact energy absorption and release.

Still further, Mudryk et al. teaches it is known to make steel roadside posts (1) with a powder coating to improve their visibility and weather resistance. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide the roadside post of Stirtz in view of Hendrickson, with a powder coating, as taught by Mudryk et al., in order to improve visibility and weather resistance of the post. See Col. 3, lns. 21-35.

With respect to claims 3-6 Stirtz discloses essentially all that is claimed, except for the use of spring steel. However, Hendrickson teaches it is known to use heat treated spring steel for the roadside support posts. Hence, it would be obvious the specific type of steel used would be a design choice, based on anticipated impact loads. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to make the roadside post of Stirtz from spring steel, as taught by Hendrickson, in order to improve impact energy absorption and release.

With respect to claims 11-16 Stirtz discloses the lower end (12) of the roadside body is adapted (by tapering) to be driven into the ground to a design depth, demarcated by a mark, such as a bend (10e) in the body (10). What Stirtz does not disclose is the use of a rigid base member fixed to the body. However, Mudryk et al., teaches it is known to provide flexible traffic posts (1) with a rigid base member (4) of galvanized steel, and having a tapered end to facilitate driving the post into a support base, such as ground or roadway. Further, Mudryk et al. clearly illustrates holes (54) in the rigid base member (4), which obviously can be used to indicate the depth to which the base is disposed in the support base, such as the ground or roadway. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide the roadside post of Stirtz, in view of Hendrickson, with a rigid base member, as taught by Mudryk et al., in order to facilitate driving the post into hard soils as are known to exist adjacent roadways, sidewalks and the like. See Col. 3, Ins. 20-34.

With respect to claims 18-23 Stirtz in view of Hendrickson disclose essentially all that is claimed, except for forming a recess in the ground adjacent the post body.

However, Mudryk et al., teaches it is well known roadside posts "have been installed by driving them into the ground, or by securing them in bore holes dug into the ground".

Hence, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to dispose the roadside post of Stirtz in view of Hendrickson, in a recess, in the ground, as taught by Mudryk et al., since to do so only requires routine skill in the art.

With respect to claim 24, Stirtz discloses the step of driving the post body into the ground.

With respect to claims 25-28, Stirtz in view of Hendrickson disclose essentially all that is claimed, except for forming a recess in the ground adjacent the post body.

However, Mudryk et al., teaches it is well known roadside posts "have been installed by driving them into the ground, or by securing them in bore holes dug into the ground".

Hence, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to dispose the roadside post of Stirtz in view of Hendrickson, in a recess, in the ground, as taught by Mudryk et al., since to do so only requires routine skill in the art.

3. Claims 7, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirtz # 5,238,322 in view of Hendrickson # 2,646,969 and Mudryk et al. # 6,267,529 B1 as applied to claim 1 above, and further in view of Kennedy # 6,375,385 B1.

The combination of paragraph 4 above, discloses essentially all that is claimed, to include a central web portion (20) and two lateral flanges (21, 22). But does not disclose a post body have a substantially arcuate transverse cross-section. However, Kennedy teaches it is well known to make spring steel roadside posts in a substantially arcuate shape to enhance strength and resilient bending when impacted by a vehicle. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to form the roadside post of Stirtz in view of Hendrickson and Mudryk et al. into an arcuate shape, as taught by Kennedy, in order to facilitate resilient bending of the post. See Kennedy Abstract.

4. Claims 3, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pellowski # 3,362,305 in view of Mathesius et al. # 2,155,349.

Pellowski discloses a roadside post (10) having a substantially arcuate shape and made of spring steel. The post (10) being bendable through 90 degrees upon impact by a vehicle or the like. See Col. 2, Ins. 20-30.

What Pellowski does not disclose is the Rockwell Hardness or carbon content of the spring steel.

However, Mathesius et al. teaches steel having high carbon contents and a Rockwell hardness less than C50 are known for having a high degree of ductility, toughness, resiliency and resistance to shock and fatigue. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to make the spring-steel roadside post of Pellowski from high carbon steel and other steel alloys having a Rockwell Hardness, less than C50, as taught by Mathesius, in order to provide the resiliency needed to bend upon impact and return to an upright condition, as suggested by Pellowski.

5. Claims 5, 6, 8, 10, 19, 20, 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pellowski # 3,362,305.

Pellowski discloses essentially all that is claimed, to include a thin resilient strip of spring steel. But does not disclose the specific dimensions of the strip element (10) nor the size of the recesses (12, 14). However, the size and thickness of the spring steel strip element (10) is a matter of design choice, dependent upon the intended use and DOT regulations or requirements. With respect to the dimensions of the recess(es) formed in the roadway, Pellowski explicitly recites "A recess (12) is drilled or otherwise formed in the surface of the highway, as shown particularly in Figures 3-5". Hence, it would be obvious to one of ordinary skill in the art, that the recess (12) could be made to any desired depth, sufficient to permit the strip element (10) to bend without being pulled out of the roadway or ground. See Col. 2, Ins. 39-50.

With respect to claims 24-28 Pellowski explicitly recites forming a recess (14) adjacent the front and rear faces of the post (10) to "eliminate a sharp edge adjacent to the strip element (10)". Pellowski further discloses "A recess (12) is drilled or otherwise formed".

It would be obvious to one of ordinary skill in the art, that the post could be driven into the ground, such as at the shoulder of a roadway, since it is well known that many road shoulders are soil or unimproved earth. Further, whether the recess (12) is drilled or formed by driving the post into the ground is simply a matter of design choice, solely based on where the post is to be located with respect to the roadway surface. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to drive the post of Pellowski into an earthen shoulder adjacent a roadway surface, in order to simplify the installation process.

6. Claims 11, 12, 22, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pellowski # 3,362,305 in view of Mudryk et al. # 6,267,529 B1.

Pellowski discloses essentially all that is claimed, to include a tapered bottom end for inserting the lower end of the post in soft ground or concrete. But does not disclose the use of a rigid base member. However, Mudryk et al. teaches it is known to provide roadside posts (1) with a tapered, rigid base member (4) to facilitate driving the post into a support base, such as the ground to a desired depth. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide

the roadside post of Pellowski with a rigid base member to facilitate driving the roadside post into hard soil, as is commonly found adjacent roadways, sidewalks and the like.

See Col. 3, Ins. 30-57.

7. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pellowski # 3,362,305 in view of Schmanski Re. 32,045.

Pellowski discloses essentially all that is claimed, except for the use of longitudinal reinforcing ribs. However, Schmanski teaches it is known to provide roadway delineators (10) with a central (11) and lateral (13) ribs to improve the elastic modulus of the delineator to a desired strength. Schmanski explicitly recites "The effect of slightly protruding rib structure(s) however, is to extend the apparent thickness of the delineator and thereby increase the moment of inertia I, without subjecting the rib structure(s) to excessive stress during the dynamic bending phase". Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide the roadway post, of Pellowski, with longitudinally extending ribs, as taught by Schmanski, in order to improve the moment of inertia and elastic modulus of the delineator. See Col. 5, Ins. 39-68.

8. Claims 32-38, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pellowski # 3,362,305 in view of Hughes # 5,205,236.

Pellowski discloses essentially all that is claimed, to include a tapered, 2 point bottom

end of the roadside post, for forcing the post into a support surface, such as a shoulder of the road. What Pellowski does not disclose is the use of a single-point ground anchor, having retaining barbs to retain the post in the ground.

However, Hughes teaches it is known to provide a roadway delineator (11) with a ground anchor (13) having at least one barb positioned along the ground anchor, to permit the delineator to be "capable of deflecting to a completely horizontal position" without being pulled from the ground by an impacting vehicle. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the roadside post of Pellowski, with a ground anchor having an outwardly tapered point and a plurality of barbs, as taught by Hughes, in order to facilitate driving the post into the ground. See Hughes Col. 1, Ins. 60-63; Col. 2, In. 64-Col. 3, In. 5.

With respect to claims 35-37 Pellowski discloses essentially all that is claimed, but does not disclose the use of a mark to indicate a desired depth of ground penetration nor the use of a ground retaining barb. However, Hughes teaches it is known to provide a roadway delineator (11) with a ground anchor (13) having at least one barb positioned along the ground anchor, to permit the delineator to be "capable of deflecting to a completely horizontal position" without being pulled from the ground by an impacting vehicle. As well as a fastener (19) receiving hole (21) positioned adjacent the ground level.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the roadside post of Pellowski, with a ground anchor having a plurality of barbs, and a hole disposed at ground level, when the post is driven into the ground, as taught by Hughes, in order to facilitate driving the post into the ground. See Hughes Col. 1, Ins. 60-63; Col. 2, In. 64-Col. 3, In. 5.

With respect to claim 38, Pellowski discloses essentially all that is claimed, except for the dimensions of the roadside post. However, the size and thickness of the spring steel strip element (10) is a matter of design choice, dependent upon the intended use and DOT regulations or requirements. See Col. 2, Ins. 39-50.

Allowable Subject Matter

9. Claims 30, 31 39 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment

10. Applicant's amendment to claim 1 has overcome the 35 USC 112 2nd Para. rejection of claims 1-31.

Response to Arguments

11. Applicant's arguments, see page 11, filed 10/21/2008, with respect to the drawing objection, cited in the last office action, have been fully considered and are persuasive. The objection to the drawings has been withdrawn.

Applicant's 1st argument against the reference to Pellowski suggests "Pellowski does not disclose a roadside post as contended by the examiner...Strip element (10)...is located on or in a road surface...Pellowski discloses such a lane marker located on a road, rather than a roadside post located on the roadside".

However, the Examiner does not concur.

It is strongly noted, Applicant discloses "common examples of roadside posts...are usually located on the edge or shoulder of roadways to delineate lanes and direct traffic".

Applicant's argument clearly overlooks Fig. 1, wherein no less than 4 "strip elements (10)" disposed on the sides of the road, such as in the shoulder of the road. Further, Pellowski discloses in Col. 6, Ins. 48-58 that "the marking devices may be located adjacent the opposite shoulders of the traffic lanes, as desired in some installations". Therefore, the argument is not persuasive and the rejection is maintained.

Applicant then argues that the Abstract in Pellowski discloses the metal strip is "embedded in a hardenable material in the highway".

However, the Examiner does not concur that a patentable distinction has been made.

Where the "post" is located, is no more than an intended use limitation in the preamble of the claim. Nothing in the body of the claim relates back to the post being particularly suited or usable on the side of the road.

Further, it well within the skill of one in the art to position the highway marker "post" of Pellowski in either the roadway, the shoulder or the ground, solely based on a design choice and intended use.

Still further, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Therefore, the argument is not persuasive and the rejection is maintained.

Applicant then argues "The strip element (10) of Pellowski cannot be described as a 'post' let alone a 'roadside post'...A post is an elongate element that has the function of supporting another object such as a delineator or sign".

However, the Examiner does not concur.

It is strongly noted Applicant does not claim a "delineator or sign" attached to the claimed post.

Applicant's argument that a post must support another object, such as a delineator or sign, clearly contradicts Applicant's own claims. None of the claims 1-10 recite nor require "a sign" or "a delineator". Further, Claim 11 positively recites "said post further

comprises a rigid base adapted to be driven into the ground".

Hence, according to Applicant's arguments, only the claimed "rigid base" of claim 11 could be considered a "post" since only the rigid base performs "the function of supporting another object such as a delineator (10).

Rather, since both Applicant and Pellowski claim a narrow elongated strip of arcuate spring steel, and that Applicant and Pellowski both disclose the use of a surface coating as well as common examples of roadside posts...are usually located on the edge or shoulder of roadways to delineate lanes and direct traffic. It is inherent the patented device and Applicant's invention are patentably identical. See Claim 1 of both the instant application and the patent to Pellowski.

Finally, as cited in claims 13, 17 it is the body/post of claim 1 that is driven into the ground, and does not support any other component or anything that could be considered a sign or delineator, since it is the delineator itself that is driven into the ground. Therefore, the argument is not persuasive and the rejection is maintained.

Applicant then argues "strip element (10)...is clearly of insufficient proportions to function as a roadside post...To function as a roadside post, supporting a delineator, a roadside post would typically need to be of a height of at least one meter".

However, the Examiner does not concur.

The feature cited, "a height of at least one meter" does not exist in any of the claims. Further, nothing in Applicant's specification even mentions the height of Applicant's invention.

The Examiner formally asks the Applicant to show where in the specification Applicant discloses the height of Applicant's "roadside post". Therefore, the argument is not persuasive and the rejection is maintained.

Applicant then suggests "Given that it is intended that the strip element (of Pellowski) is intended to be regularly impacted by vehicles changing lanes".

It is unclear as to where Applicant's suggestion is derived. The suggestion that the element (10) of Pellowski is "intended to be regularly impacted by vehicles changing lanes" appears to be nothing more than conjecture.

It is requested by the Examiner that Applicant show where in the specification of Pellowski it is disclosed that the strip element (10) "is intended to be regularly impacted by vehicles changing lanes". It does not appear as though such a disclosure exists. Therefore, the argument is not persuasive and the rejection is maintained.

Applicant then argues "Patent No. 3,312,156 to Pellowski...was recently considered by the Federal Court of Australia in proceedings relating to infringement".

However, the '156 patent is has not been used in the rejection of any of the cited claims. Further, neither the Examiner no Applicant has cited the '156 patent on a Notice of References Cited or an IDS.

Hence, any discussion of the '156 patent is irrelevant to the claimed invention and any rejection put forth by the Examiner.

Still further, regardless of what any foreign authority might discuss or decide is not binding on the Examiner.

Therefore, the argument is not relevant and the rejection is maintained.

With respect to Applicants arguments with respect to the Affidavit by Mr. Dowling; the declaration has been placed in the application but not considered since they do not have the appropriate statutory declaration set forth in MPEP 602 II. However, it should be noted that even if the declarations were resubmitted with the appropriate statutory declarations they would not be persuasive to overcome the art of record in that there is not a nexus between the evidence submitted and the art of record applied to the current claims record. Furthermore, the Application is subject to U.S. laws and the Examiner is not bound by any decision made by courts outside the United States.

Applicant argues in favor of claim 9 by suggesting "Pellowski does not disclose the body as having a channel shaped transverse cross-section comprising a central web and two lateral flanges...Pellowski has a relatively flat, arcuate cross-section.

However, since Pellowski's disclosure, as put forth by Applicant above, clearly reads on the post illustrated in Figs. 2a, 2b, which is the only embodiment claimed and disclosed in the specification.

Hence, no patentable distinction appears to exist between claim 9, and the prior art.

See Claim 1 of Pellowski as well as Col. 2, Ins. 20-30.

Applicant then argues in favor of claims 13, 14 by suggesting "the lower end (11) of the strip element (10)...is not tapered as contended by the Examiner...while the notch (15) forming the sharp points may allow the post to be pressed into a hardenable material...this arrangement would not enable the post to readily be driven into a ground surface".

However, the Examiner does not concur.

Nothing in the claims 13, 14 preclude the notch (15) of Pellowski from reading on "said body first end is tapered", because nothing in claim 14 defines how or in what way the end of the body is tapered. Further, Applicant's suggestion the notch (15) would not enable the post to be readily driven into a ground surface, appears to be conjecture.

Further, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69USPQ 138.

Still further, as readily admitted by Applicant, Pellowski discloses "to sharp point are formed at either edge thereof which aid in forcing the strip element (10) into the hardenable material (13). Clearly, a post that can be forced into a hardenable material, such as concrete or cement, would certainly be "adapted to" be driven into the ground.

Therefore, the arguments are not persuasive and the rejection is maintained.

Applicant argues in favor of claims 15, 16 by suggesting "Pellowski fails to disclose a mark indicative of the location of the surface of the ground when the post is driven into the ground to a design depth...these holes are to aid in holding the post firmly in the ground...If the holes were to be indicative of the location of the surface of the ground, they would clearly have no role in holding the post firmly in the ground".

However, the Examiner does not concur.

Pellowski clearly discloses a plurality of holes (16) adjacent the lower end (11). Further, it is inherent that depending how deeply the post is driven into the ground or the roadway, that some of the plurality of holes would be located at ground level, above ground level and below ground level, at least one hole being indicative of the ground level, with respect to the post, solely based on how deeply the post is driven.

Still further, since Pellowski clearly discloses the holes are "adjacent the lower end (11). And that the "lower end portion (11)...is positioned within the recess (12)". It is inherent that at least a few of the plurality of holes 16 that are adjacent the lower portion (11) would in fact be at or even possibly above the ground level, when the lower end portion (11) is placed in the recess (12) to a desired design depth".

Therefore, the argument is not persuasive and the rejection is maintained.

Applicant then argues in favor of claim 17 by suggesting "Pellowski fails to disclose a roadside post installation comprising a roadside post or a method in which the post is driven into the ground".

However, the Examiner does not concur.

Although Pellowski discloses forming a recess (12) placing the post (10) into the recess and filling the recess with a hardenable material, it is inherent one of ordinary skill in the art could drive the post into the ground when the post is positioned on the shoulder of the road, as disclosed by Pellowski, and the shoulder of the road is earth, which is known. See Col. 4, lns. 48-58.

Applicant then argues against the rejection of claims 1-6, 9-28 by suggesting Stirtz discloses a road marker in the form of an elongate strip of material of a plastic or resin composition. "Accordingly Stirtz clearly teaches directly away from forming the marker from a steel material and the asserted combination of this disclosure with the teachings of Hendrickson is thus improper".

However, the Examiner does not concur.'

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further Stirtz discloses the claimed invention except for the use of spring steel. It would have been obvious to one of ordinary skill in the art, at the time the invention was made to make the post of Stirtz from spring steel, since it has been held to be within the general skill of a worker in the art, to select a known material on the basis of its

suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. In this case both resilient plastic and spring steel are known to be used in forming roadside posts capable of elastic deformation when impacted by a vehicle.

Applicant then argues separately the reference to Hendrickson by suggesting "Hendrickson discloses a highway guard with support members formed of multiple leaf spring elements...is not directed to a roadside post and is not directed to any element that is elastically bendable through 90 degrees...Hendrickson fails to teach the use of sheet spring steel...Hendrickson clearly being in the nature of plate steel rather than spring steel...A person of ordinary skill in the art, would clearly not consider the rigid support member of Hendrickson to be of any relevance when considering the design of a flexible roadside post".

However, the Examiner does not concur.

Hendrickson explicitly recites "the steel must be capable of withstanding high stresses without permanent deformation and...I prefer to use heat treated spring steel for the bumper strip supports". Hence, Hendrickson clearly discloses the use of spring steel.

Further, in response to Applicant's argument that "If the person of ordinary skill...were to modify the roadside post of Stirtz to form it of heat treated spring steel of the type and configuration taught by Hendrickson, being multiple heavy leaf springs, to improve impact energy absorption...a rigid roadside post would be the result", it has been held that the test for obviousness is not whether the features of one reference may

be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case Stirtz discloses essentially all that is claimed, except for the use of spring steel. Hendrickson teaches it is known to form roadside posts of spring steel. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to form the roadside post of Stirtz from spring steel, as taught by Hendrickson in order to increase impact energy absorption and release.

Further, in light of Applicant's argument that a roadside post is intended to support another object; Hendrickson clearly discloses and illustrates a bumper strip or guardrail (10) supported by at least one spring steel element (14, 15, 16). Therefore, the argument is not persuasive and the rejection is maintained.

Applicant then cites a Statutory Declaration executed by Laurence Bede Dowling, and another Statutory Declaration by executed by Gabriel Tana; the declarations have been placed in the application but not considered since they do not have the appropriate statutory declaration set forth in MPEP 602 II. However, it should be noted that even if the declarations were resubmitted with the appropriate statutory declarations they would not be persuasive to overcome the art of record in that there is not a nexus between the evidence submitted and the art of record applied to the current claims record. Furthermore, the Application is subject to U.S. laws and the Examiner is not bound by any decision made by courts outside the United States.

With respect to Applicants suggestion that commercial success of the device should be considered; Merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte Remark*, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). Further, the statement of commercial success fails to show that the commercial success was not due to extensive advertising and position as a market leader before the introduction of the product.

Therefore, the argument is not persuasive and the rejection is maintained.

Applicant then reverts to arguing against the reference to Stirtz by suggesting "Stirtz is clearly not elastically bendable through 90 degrees to either side of a longitudinal axis".

However the Examiner does not concur.

Fig. 2 of Stirtz clearly illustrates the roadside post being bendable through 90 degrees.

It is strongly noted that although Claim 1 was rejected as unpatentable over Stirtz in view of Hendrickson and Mudryk; Applicant has failed to discuss the reference to Mudryk.

Hence, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant then repeats the argument that Hendrickson does not disclose sheet spring steel, in regards to claims 3-6. However, none of the claims specifically recite nor require the use of sheet spring steel. The claims only require the use of spring steel; which is taught by Hendrickson.

Applicant argues against the reference to Mudryk, separately, with respect to claim 16, by suggesting "While the Examiner refers to holes (54) in the rigid base member (4) of Mudryk, there are no such holes having reference numeral (54).

However, the Examiner does not concur. See Figs. 19, 16, 9.

In Fig. 1 the holes in post member (4) are numbered (12).

Further, Mudryk discloses the lower post member (4) is to be driven into the ground. Hence, with holes (12) or (54) positioned adjacent the top of the post member (4), it would be obvious to one of ordinary skill in the art, the post can be driven into the ground until one or more holes (12), (54) are level with the ground surface, to facilitate bending of the flexible traffic post when impacted by a vehicle.

Therefore, the argument is not persuasive and the rejection is maintained.

With respect to claims 18-21 Applicant argues "A person of ordinary skill in the art will clearly understand the use of the terminology 'securing' and the use of cement, that the post will fully fill the borehole dug into the ground such that no recess will remain, or alternatively that cement will be used to fill any recess left between the post and the wall

of the borehole...securing a post within the borehole teaches directly away from leaving a recess to allow uninhibited bending of the body".

However, the Examiner does not concur.

As Applicant readily admits that Mudryk discloses installing the posts by securing them in boreholes. Which meets the structural limitations of claims 18 and 21, since it is obvious the post is positioned in the center of the borehole, leaving recesses adjacent each side of the post. How much cement is used to and to what extent the borehole is filled with cement is an obvious design choice, which as Mudryk discloses is used only "if required". Further, with respect to the intended use limitation "to allow uninhibited bending of said body"; it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ2d 1647 (1987).

Applicant is again reminded Mudryk discloses the use of cement is optional and not required.

Therefore, the argument is not persuasive and the rejection is maintained.

With respect to claims 22, 23 Applicant argues none of the references to Stirtz, Hendrickson nor Mudryk disclose or suggest placing the entire base underground. However, Mudryk et al., teaches it is well known roadside posts "have been installed by driving them into the ground, or by securing them in bore holes dug into the ground".

It is well within the skill of one in the art, to position the base entirely below ground, which only requires driving the post into the ground to said desired depth or forming a borehole of a desired depth.

Further, Stirtz in view of Hendrickson and Mudryk disclose the claimed invention except for the explicit recitation of how deeply to insert the base of the post into the ground. It would have been an obvious matter of design choice to place the base to a desired depth, since Applicant has not disclosed that placing the base entirely underground as opposed to partially underground serves any additional function, and it appears that the invention would perform equally well with the base partially underground.

Applicant argues against the rejection of claims 7, 8 as unpatentable over Stirtz in view of Hendrickson and Mudryk and further in view of Kennedy, by suggesting claims 7, 8 are patentable due to their dependency from claim 1. And that Mudryk fails to teach the dimensional features in claim 8.

However, Kennedy clearly discloses in col. 5, lns. 5-15 that "Spring steel elements (12)...is preferably formed of a resilient spring steel...with the thickness and width of each blade or element being adjusted accordingly. The preferred spring steel material provides the desired resiliency and return after being deformed".

Hence the width, thickness and degree of curvature, of each spring steel element, is adjusted based on anticipated impact forces.

Applicant argues against the rejection of claims 3, 4 as being unpatentable over Pellowski in view of Mathesius et al. by stating "claims 3 and 4 depends from allowable independent claim 1...Mathesius discloses the use of steel having a Rockwell hardness of not more than 50c, there is no teaching or suggestion of the use of steel having a Rockwell hardness between 50c and 47c, let alone the use of spring steel".

However, the Examiner does not concur.

Pellowski discloses the use of spring steel roadside posts that are resilient and shock resistant, in order to permit temporary deformation during an impact by a vehicle. What Pellowski does not disclose is the hardness of the spring steel.

However, Mathesius teaches high carbon steel articles are known to have a Rockwell hardness less than C50 and are known for having a high degree of ductility, toughness, resiliency and resistance to shock and fatigue. Therefore, it would have been obvious the spring steel of Pellowski would have a Rockwell hardness of at least 50c in order to withstand the shock caused by an impacting vehicle. The fact neither Pellowski nor Mathesius do not explicitly recite the use of steel having a hardness of C40-C47 is not a patentable distinction because It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a high carbon spring steel having a Rockwell hardness of C40-C47, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ (CCPA 1980).

Therefore, the argument is not persuasive and the rejection is maintained.

Applicant then argues against the rejection of claims 5, 6, 8, 10, 19, 20, 26, 27 as unpatentable over Pellowski by referring to their dependency from Claim 1.

And then states "given the nature of Pellowski in disclosing a small strip element forming a lane marker on the road...between lanes, as opposed to a roadside post".

However, Fig. 1 of Pellowski clearly shows more posts disposed on the side of the roadway than in between lanes of the roadway, i.e. 2 posts in the roadway and 4 posts on the sides of the highway.

Applicant then argues "following the directions of Pellowski would result in quite a different configuration...the recess (of Pellowski) is formed in the surface of the highway...rather than in the ground in a roadside location".

However, Fig. 1 as well as col. 4, Ins. 48-58 clearly disclose positioning the majority of the posts in the shoulder of the road.

Further, the recitation that the post is a "roadside post" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Applicant argues on page 26 of the arguments that claims 11, 22, 23 are unpatentable over Pellowski in view of Mudryk by stating "Each of these rejected claims depends from claim 1 and is allowable at least by virtue of depending from an allowable claim".

However, the Examiner does not concur.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant then suggests a person of ordinary skill in the art would not contemplate providing the roadside post of Pellowski with a rigid base...given that Pellowski is not directed to the installation of roadside posts adjacent roadways.

As put forth above, Pellowski clearly discloses positioning roadside posts in the shoulder, adjacent the roadway, as shown in Fig. 1; and disclosed in Col. 4, Ins. 48-58.

Therefore, the argument is not persuasive and the rejection is maintained.

Applicant argues against the rejection of claim 29 as being unpatentable over Pellowski in view of Schmanski by suggesting "a person...would not consider modifying the strip element of Pellowski to include ribs as disclosed in Schmanski in view of the different purpose of the lane markers of Pellowski and their relatively small size. The inclusion of ribs in the relatively small strip elements of Pellowski...would tend to provide a strip element of excessive stiffness for its intended purpose of being regularly impacted".

However, the Examiner does not concur.

It appears to be simple conjecture on part of Applicant to characterize the post of Pellowski as "relatively small size". Nothing in the actual language of Pellowski discloses the size/height of the post.

Further, as put forth repeatedly, Applicant's suggestion that Pellowski does not position posts on the side of the road, clearly ignores the illustration of Fig. 1 and the disclosure of Col. 4, Ins. 48-58. Which clearly and explicitly positions the posts in each shoulder, adjacent the roadway.

Further, Applicant's insistence that Pellowski intends the posts be "regularly impacted" does not appear to have antecedent basis in the Pellowski patent. Hence, Applicant's insistence that Pellowski intends to have the posts "regularly impacted" appears to be conjecture on Applicant's part, and is not supported by any actual language in the Pellowski patent.

Therefore, the argument is not persuasive and the rejection is maintained.

Applicant's arguments in favor of New claims 32-40 are noted. Claims 32-38, 40 have been rejected on the merits as put forth above. And Claim 39 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Oath/Declaration

12. The Statutory Declarations filed 10/21/2008; have been placed in the application but not considered since they do not have the appropriate statutory declaration set forth

in MPEP 602 II. However, it should be noted that even if the declarations were resubmitted with the appropriate statutory declarations they would not be persuasive to overcome the art of record in that there is not a nexus between the evidence submitted and the art of record applied to the current claims record. Furthermore, the Application is subject to U.S. laws and the Examiner is not bound by any decision made by courts outside the United States.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond W. Addie whose telephone number is 571 272-6986. The examiner can normally be reached on 7am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 571 272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raymond W. Addie/
Primary Examiner, Art Unit 3671

11/21/2008